

## REMARKS

Claims 1-22 and 38-52 are pending in the application. Claims 1-3, 13, 14, 22, 38, 45, 47, 48, 49 and 52 are currently amended. The amendments do not present any new matter. *See, e.g.*, Figs. 20-24; para. 108. Claims 9, 12, 19, 21, 23, 44 and 46 are presently withdrawn from consideration, but will be reinstated upon allowance of the respective independent claim (and any intervening dependent claim) from which they depend. Reconsideration and allowance of the application, as amended, are respectfully requested.

### **I. Claims 1-6, 8, 11, 13-16, 18, 22, 38-41, 43, 45, 47 and 51-52 are Patentable Over Phan, Tetzlaff and Hooven**

Independent claims 1, 14, 38 and 47 and respective dependent claims 2-6, 8, 11, 13, 15, 16, 18, 22, 39-41, 43, 45 and 51-52 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,692,491 to Phan (hereafter “Phan”) in view of U.S. Patent No. 6,277,117 to Tetzlaff *et al.* (hereafter “Tetzlaff”) and in further view of U.S. Patent No. 6,889,694 to Hooven (hereafter “Hooven”).

To establish *prima facie* obviousness of a claim, all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03. Additionally, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so, *i.e.*, the prior art must suggest the desirability of the claimed invention. MPEP §2143.01, citing *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (motivation-suggestion-teaching requirement as a guard against using hindsight in an obviousness analysis). Further, identification in the prior art of individual parts that are claimed is insufficient to defeat patentability of the whole claimed invention. *In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01 (emphasis added), citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Also, the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason, without the benefit of Applicant’s specification, to make the necessary changes. MPEP §2144.04.

To support the rejection, the Office Action relies on support members 194 and 196 described by Phan, the insulative substrates 111 and 121 (the asserted removable base members) described by Tetzlaff, and the electrodes 120 and 172, described by Hooven. The Office Action alleges it would have been obvious to modify the support member 194 and 196 configuration described by Phan to have a removably securable electrode assembly that has a support member that carries both a coagulation element and a stimulation element as allegedly disclosed by Tetzlaff and Hooven. Applicant respectfully submits that the rejection and the cited references relied upon by the Office Action are moot in view of the amended claims.

It is conceded in the Office Action that Phan fails to disclose support members that are removably secured to clamp members and that the support members stimulation elements. Thus, Phan also fails to disclose, teach or suggest “a base member configured to be removably secured to a first clamp member” as recited in claims 1, 14, 38 and 47. Further, Phan fails to disclose, teach or suggest “a support member, the base member being configured to receive the support member” as recited in claims 1, 14, 38, 47. Moreover, Phan fails to disclose, teach or suggest “a coagulation element carried by the support member” that is received by a base member configured to be removably secured to a clamp member, and a “stimulation element” that is carried by the same support member as recited in claims 1, 14, 38 and 47.

Tetzlaff and Hooven also fail to disclose, teach or suggest both “a base member configured to be removably secured to a first clamp member,” and “a support member, the base member being configured to receive the support member,” as recited in claims 1 and 14, 38, 47. The insulative substrates 111 and 121 (the alleged base members) described by Tetzlaff cannot support the rejection since they do not receive a support member, as recited in the claims. Tetzlaff (Fig. 7). Further, as shown in Fig. 6 of Tetzlaff, the substrate 121 includes bifurcated detents 122 and a pin 124 extending upwardly from a top of the substrate 121. Moreover, the configuration described in Hooven does not involve removable components.

Both Tetzlaff and Hooven also fail to disclose, teach or suggest “a coagulation element carried by the support member” that is received by a base member configured to be removably secured to a clamp member, and a “stimulation element” that is carried by the same support member. In contrast, Tetzlaff describes an electrode 120 fixed at an end of a prong. Hooven describes a fixed jaw assembly 116 having a fixed electrode 120, and pacing electrodes 172 and EKG electrodes 174 on a side of the jaw assembly 116, but does not otherwise disclose or suggest the structural configurations recited in claims 1, 14, 38 and 47. Hooven (col. 15, lines 28-46; Fig. 66).

Consequently, even assuming *arguendo* that the asserted combination of the these references could be properly made, their combination would nevertheless fail to disclose each element of claims 1, 14, 38 and 47. Therefore, the §103 claim rejections cannot stand for this reason alone. MPEP §2143.03. Further, the required suggestion or motivation to modify Phan and combine Phan with Tetzlaff and Hooven is lacking. Simply because Tetzlaff may describe removable components and Hooven may disclose certain electrodes is not sufficient to support an assertion that there is a suggestion or motivation to modify Phan to have a removable base member and, in addition, that the same member would carry both a coagulation element and a stimulation element. The statements made in the Office Action regarding the propriety of the three-way reference combination do not take into account the particular structural configuration of the devices described in each of the references, and essentially amount to a bald assertion that such a change “can” be made. However, such an unsupported assertion cannot serve as a basis for the rejection.

In particular, Phan explains that, given the distance that the curved arm distal portions 190 and 192 are capable of moving, the coagulation apparatus 178 includes a pair of operative element support members 194 and 196. These support members 194 and 196 are connected to a connector 172 by a pair of electrical conduits 198 and 200. Phan also refers to a support member 168 and explains that the support member 168 is a continuous structure, but for the break at the distal end of the arm distal portions 160 and 162 that allows the device to be opened and closed. Phan further explains that the support member 168 is preferably “mounted off center.” This “off center” configuration is shown in Figure 24. Phan does not disclose that the support members 194 and 196 (and the support member 168) are removable, and modifying Phan as such would involve substantial changes to the structure described by Phan, the off center mounting and the connections to the connector 172 and conduits 198 and 200. Consequently, the required suggestion or motivation to modify Phan based on the asserted combination is lacking.

Accordingly, Applicant respectfully submits that independent claims 1, 14, 38 and 47 are patentable over Phan, Tetzlaff and Hooven, individually and in combination. Dependent claims 2-6, 8, 13, 15, 16, 18, 22, 39-42, 45 and 52 incorporate the elements and limitations of respective independent claims 1, 14, 38 and 47 and, therefore, are also believed allowable over these references.

## **II. Claims 7, 17 and 42 are Patentable Over Phan, Tetzlaff, Hooven and Bowe**

Dependent claims 7, 17 and 42 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Phan, Tetzlaff and Hooven in still further view of U.S. Patent No. 6,771,996 to Bowe *et al.* (hereafter “Bowe”). In other words, combining four different references! Bowe is cited for the limited purpose of allegedly disclosing coagulation electrode length(s) that are greater than the mapping/stimulation electrode length(s). However, Bowe does not cure the deficiencies of Phan, Tetzlaff and Hooven since Bowe does not disclose, teach or suggest all of the elements of the independent claims and the structural relationships recited in these claims. Further, the required suggestion or motivation to combine the references is lacking as discussed above. Dependent claims 7, 17 and 42 incorporate the elements and limitations of respective independent claims 1, 14 and 38 and, therefore, are also allowable. MPEP §2143.03.

### **III. Claims 10, 20 and 50 are Patentable Over Phan, Tetzlaff, Hooven and Maguire**

Dependent claims 10, 20 and 50 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Phan, Tetzlaff and Hooven and further in view of U.S. Patent No. 6,997,925 to Maguire *et al.* (“Maguire”). Again, combining four different references! Maguire is cited for the limited purpose of allegedly disclosing delivering ablative / coagulating energy to cardiac tissue and the alternative of delivering ablating / coagulating energy via resistive heating, RF current and ultrasound that are “sufficient to ablate tissue when coupled to a suitable excitation source.” However, Maguire does not cure the deficiencies of Phan, Tetzlaff and Hooven since Maguire does not disclose, teach or suggest all of the elements of the independent claims and the structural relationships recited in these claims. Further, the required suggestion or motivation to combine the references is lacking as discussed above. Dependent claims 10, 20 and 50 incorporate the elements and limitations of respective independent claims 1, 14 and 47 and, therefore, are also allowable. §MPEP 2143.03.

**CONCLUSION**

In view of the foregoing claim amendments and remarks, Applicant respectfully submits that the application is in condition for allowance. If there are any remaining issues that can be resolved by telephone, Applicant invite the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

**VISTA IP LAW GROUP LLP**

Dated: April 26, 2007

By: /David T. Burse/  
David T. Burse  
Reg. No. 37,104  
Attorneys for Applicants

12930 Saratoga Avenue, Suite D-2  
Saratoga, California 95070  
Telephone: (408) 777-2905  
Facsimile: (408) 877-1662